

REMARKS

This is a fully and timely response to the non-final Office Action mailed October 26, 2004. Reconsideration of the application in light of the following remarks is respectfully requested.

No claims are added or cancelled by this paper. Thus, claims 2-10, 12-15, 18-23, 29, 33-37, 44, 45 and 47-60 remain pending for the Examiner's consideration.

Various claims have been amended herein. These amendments are *not* made in response to cited prior art or for any reason other than Applicant's desire to broaden the scope of the claimed subject matter. The amendments made by the present paper do *not* narrow the scope of any claim.

§ 102 Rejection based on Schwenk:

With regard to the prior art, the present Office Action rejects claims 2, 3, 7-9, 12-14, 18, 22, 29, 31, 36, 44 and 49 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,704,403 to Schwenk et al. ("Schwenk"). ***Applicant had anticipated this rejection and explained the shortcomings of the Schwenk reference in a preliminary amendment filed with the present application. The recent non-final Office Action does not address or respond to the arguments Applicant made in that preliminary amendment and is, consequently, incomplete and ineffective.***

Claim 2 recites:

An ink cartridge refilling system comprising:
a receptacle for receiving an ink cartridge;
a supply of ink;

a refilling mechanism for automatically adding ink to said ink cartridge from said supply of ink; and
a user interface for controlling said adding of ink to said ink cartridge.

In contrast, Schwenk does not teach or suggest the claimed “user interface for controlling said adding of ink to said ink cartridge.” Similar subject matter is also recited in other pending claims, for example, claim 18.

The recent Office Action alleges that Schwenk teaches a user interface, but does not explain how or where Schwenk teaches the user interface as claimed for controlling the adding of ink to an ink cartridge. It is incumbent upon the Office to identify where in the cited reference each element of the claim may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, the Office Action has failed to make out a *prima facie* case of unpatentability as to claims 2 and 18 and their dependent claims.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, the rejection of claims 2, 3, 9, 18 and 49 based on Schwenk should be reconsidered and withdrawn.

Claim 7 recites:

An ink cartridge refilling system comprising:
a receptacle for receiving an ink cartridge;
a supply of ink;
a refilling mechanism for automatically adding ink to said ink cartridge from said supply of ink; and
a cartridge diagnostic unit for evaluating said cartridge prior to refilling said cartridge to determine to what extent said cartridge can be refilled.

In contrast, Schwenk does not teach or suggest the claimed “cartridge diagnostic unit for evaluating said cartridge prior to refilling said cartridge to determine to what extent said cartridge can be refilled.” Similar subject matter is also recited in other pending claims, for example, claim 22.

Again, the recent Office Action baldly alleges that Schwenk teaches “diagnostics,” but does not explain how or where Schwenk teaches the cartridge diagnostic unit as claimed for evaluating a cartridge prior to refilling that cartridge to determine to what extent the cartridge can be refilled. It is incumbent upon the Office to identify where in the cited reference each element of the claim may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, the Office Action has again failed to make out a *prima facie* case of unpatentability as to these claims.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, the rejection of claims 7, 8, 22 and 29 based on Schwenk should be reconsidered and withdrawn.

Claim 44 recites:

A method of adding ink to an ink cartridge, said method comprising:
placing said ink cartridge in a ink cartridge refilling system;
ascertaining information about said ink cartridge; and
if said information about said ink cartridge matches predetermined parameters,
refusing to add ink to said cartridge with an automated refilling mechanism of said ink
cartridge refilling system.

In contrast, Schwenk does not teach or suggest “refusing to add ink to said cartridge” “if said information about said ink cartridge matches predetermined parameters,” as claimed. The recent Office Action does not address claim 44 or the position taken by Applicant in the earlier preliminary amendment. ***The Office Action does not even allege that Schwenk teaches “refusing to add ink” to a cartridge under certain conditions as claimed.***

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, the rejection of claim 44 based on Schwenk should be reconsidered and withdrawn.

§ 103(a) Rejection Based on Schwenk and Howlett:

Claims 4-6, 10, 15, 19-21, 23, 33-35, 37, 48, 51 and 59 were rejected as unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Schwenk and U.S. Patent No. 5,203,387 to Howlett et al. (“Howlett”). ***Again, Applicant had anticipated these rejections and explained the shortcomings of the Schwenk and Howlett references as applied to these claims in a preliminary amendment filed with the present application. The recent non-final Office Action does not address or respond to the arguments Applicant made in that preliminary amendment and is, consequently, incomplete.***

Claim 10 recites:

An ink cartridge refilling system comprising:
a receptacle for receiving an ink cartridge;
a supply of ink;

a refilling mechanism for automatically adding ink to said ink cartridge from said supply of ink; and
a receipt printer.

In contrast, Schwenk does not teach or suggest the recited “receipt printer.” The Office Action seems to suggest that Howlett teaches the claimed receipt printer. However, the Office Action does not specifically allege that Howlett teaches the claimed receipt printer, nor does the Action indicate how or where Howlett contains such a teaching.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Consequently, the rejection of claim 10 and its dependent claims based on Schwenk and Howlett should be reconsidered and withdrawn.

Claim 4 recites:

An ink cartridge refilling system comprising:
a receptacle for receiving an ink cartridge;
a supply of ink;
a refilling mechanism for automatically adding ink to said ink cartridge from said supply of ink; and
a label reading mechanism for reading an identification label on said ink cartridge.

In contrast, Schwenk fails to teach or suggest a label reading mechanism or identification label on an ink cartridge. Howlett teaches a bar-code on a paint can that specifies the color or color components of the paint to be mixed in that can. The bar-code taught by Howlett is not an “identification label” that identifies one can of paint from another, as claimed. Moreover, none of the prior art reference teach or suggest an identification label on an ink cartridge.

Consequently, the combined prior art fails to teach or suggest the claimed identification label on an ink cartridge and a reader for such a label. Similar subject matter is also recited in other pending claims, for example, claims 15, 19, 33 and 36.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, the rejection of claims 4, 15, 19, 33 and 36, and their respective dependent claims, based on Schwenk and Howlett should be reconsidered and withdrawn.

§ 102 Rejection based on Kong:

Claim 60 was rejected as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,273,151 to Kong ("Kong"). For at least the following reasons, this rejection is also traversed.

An ink cartridge refilling system comprising:
a receptacle for receiving an ink cartridge;
a supply of ink;
a refilling mechanism for automatically adding ink to said ink cartridge from said supply of ink; and
a locking mechanism for locking said cartridge in said receptacle to prevent premature removal of said cartridge from said receptacle.

In contrast, Kong does not teach or suggest the claimed locking mechanism that "prevent[s] premature removal of said cartridge from said receptacle." Rather, Kong merely teaches clips (54, 56) which "restrain" movement of the cartridge while it is being refilled. (Kong, col. 2, lines 58-63). These clips do not "prevent" removal of the cartridge, nor does Kong teach that they do. The clips can be moved aside at anytime to remove the cartridge. Rather, the clips merely "restrain" movement of the cartridge during the refill process.

Consequently, Kong fails to teach or suggest the locking mechanism of claim 60. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, the rejection of claim 60 based on Kong should be reconsidered and withdrawn.

Double Patenting Rejection:

The recent Office Action concludes by rejecting claims 2-10, 12-15, 18-23, 29, 33-37, 44, 45 and 47-60 under the judicially-created doctrine of obviousness-type double patenting in view of claims 1-39 of U.S. Patent No. 6,729,360. While Applicant does not necessarily agree that the rejected claims are obvious over the claims of the '360 patent, in order to expedite allowance of the present application, Applicant has filed herewith a terminal disclaimer of the present application as to U.S. Patent No. 6,729,360. Consequently, following entry of this terminal disclaimer, the double patenting rejection of the present Office Action should be withdrawn.

Allowable Subject Matter:

Applicant wishes to note on the record that claims 45, 47, 50 and 52-58 are rejected only under the doctrine of double patenting. There is no prior art rejection in the present Office Action of claims 45, 47, 50 and 52-58. Consequently, Applicant presumes that these claims present allowable subject matter and are patentable over the prior art of record, after the double patenting rejection has been overcome. Notice to this effect and a recognition of the allowable subject matter of claims 45, 47, 50 and 52-58 is respectfully requested.

Conclusion:

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



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DATE: 13 January 2005

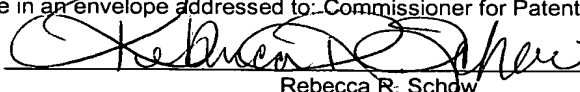
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